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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/778,018	02/12/2004	Steven St. Martin	22727/04212	3349

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EXAMINER

ROBINSON, KEITH O NEAL

ART UNIT PAPER NUMBER

1638

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/778,018

Applicant(s)

MARTIN ET AL.

Examiner

Keith O. Robinson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, drawn to a method for determining the *Phytophthora sojae* resistance associated with the trait locus *Rps8* in soybean and a soybean seed produced from said method, classified in class 435, subclass 6, for example.
 - II. Claims 4-9, drawn to a method for introgressing soybean *Phytophthora sojae* resistance into non-resistant soybean germplasm and soybean seed produced from said method, classified in class 800, subclass 265, for example.
 - III. Claims 10-19, drawn to a method for the production of a soybean cultivar adapted for conferring, in hybrid combination with a susceptible second inbred, resistance to *Phytophthora sojae*, classified in class 800, subclass 269, for example.
 - IV. Claims 20-24, drawn to a soybean plant or seed, classified in class 800, subclass 312, for example. If this group is chosen, Applicant is required to elect one of the germplasms (i.e. HFX01-602 or OX-98317 or OX-99218) as each germplasm is considered a separate and distinct invention.
2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

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operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions I and II are unrelated because Invention I is drawn a method for determining *Phytophthora sojae* resistance and Invention II is drawn to a method for introgressing *Phytophthora sojae* resistance and each invention would require different modes of operation. For example, the DNA isolation steps that would be required for Invention I are not required for Invention II.

Furthermore, searching the invention of Invention I together with the invention of Invention II would impose a serious search burden. In the instant case, prior art searches of a method for determining *Phytophthora sojae* resistance are not coextensive with prior art searches of a method for introgressing soybean *Phytophthora sojae* into non-resistant soybean. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions I and II together.

3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions I and III are unrelated because Invention I is drawn a method for determining *Phytophthora sojae* resistance and Invention III is drawn to a method for the production of a soybean cultivar adapted for conferring

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resistance to *Phytophthora sojae* and each invention would require different modes of operation. For example, the steps required in Invention III to produce a hybrid are not required for Invention III.

Furthermore, searching the invention of Invention I together with the invention of Invention III would impose a serious search burden. In the instant case, prior art searches of a method for determining *Phytophthora sojae* resistance are not coextensive with prior art searches of a method for the production of a soybean cultivar adapted for conferring resistance to *Phytophthora sojae*. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions I and III together.

4. Inventions I and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process, for example, by using backcrossing techniques.

Furthermore, searching the invention of Invention I together with the invention of Invention IV would impose a serious search burden. In the instant case, prior art searches of a method for determining *Phytophthora sojae* resistance are not

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coextensive with prior art searches of soybean germplasm. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions I and IV together.

5. Inventions II and III are patentably distinct. These inventions are different because Invention II involves a method for introgressing soybean *Phytophthora sojae* resistance into non-resistant soybean germplasm and Invention III involves a method for the production of a soybean cultivar adapted to conferring resistance to *Phytophthora sojae*. Each invention would require different steps, for example, the soybean cultivar required for Invention III is not required for Invention II.

Furthermore, searching the invention of Invention II together with the invention of Invention III would impose a serious search burden. In the instant case, prior art searches of a method for introgressing soybean *Phytophthora sojae* resistance into non-resistant soybean germplasm are not coextensive with prior art searches of a method for the production of a soybean cultivar adapted to conferring resistance to *Phytophthora sojae*. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and

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examination. As such, it would be burdensome to perform examination of inventions II and III together.

6. Inventions II and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process, for example, by using backcrossing techniques.

Furthermore, searching the invention of Invention II together with the invention of Invention IV would impose a serious search burden. In the instant case, prior art searches of a method for introgressing soybean *Phytophthora sojae* resistance into non-resistant soybean germplasm are not coextensive with prior art searches of soybean germplasm. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions II and IV together.

7. Inventions III and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process

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(MPEP § 806.05(f)). In the instant case product can be made by another and materially different process, for example, by using backcrossing techniques.

Furthermore, searching the invention of Invention III together with the invention of Invention IV would impose a serious search burden. In the instant case, prior art searches of a method for the production of a soybean cultivar adapted for conferring, in hybrid combination with a susceptible second inbred, resistance to *Phytophthora sojae* are not coextensive with prior art searches of soybean germplasm. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions III and IV together.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 571-272-0745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith O. Robinson, Ph.D.

July 26, 2005

DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "David H. Kruse", written in a cursive style.